

## REMARKS

Claims 1-14, 16-40 and 42-50 are pending in the present application. Applicant has amended claims 1, 14, 16, 23-25, 32, 49 and 50, and traverses the rejections as follows.

### Response to Claim Objections

The Examiner has objected to claim 16 due to a typographical error in the claim. Applicant has amended claim 16 accordingly.

### Rule 131 Declarations

In rejecting Applicant's claims, the Examiner has relied significantly on the Jan/Feb 2003 issue of Dental Practice Report ("Dental Practice Report"). As a preliminary matter, Applicants submit that Dental Practice Report is not a proper prior art reference. Applicant's application benefits from the priority date of U.S. Provisional Application No. 60/455,773 filed March 19, 2003. Concurrently with this Response, Applicants have submitted a declaration pursuant to 37 CFR § 1.131. Applicants respectfully suggest that if the Dental Practice Report discloses information sufficient to reject Applicants' claims, this declaration establishes the invention of the subject matter of the rejected claims before the effective date of the Dental Practice Report reference.

### Response to Claim Rejections under 35 U.S.C. § 112

Claims 1-14, 16-32, 49 and 50 stand rejected under 35 U.S.C. § 112, second paragraph. Applicant amends and traverses the rejections as follows.

The Examiner asserts that claims 1 and 32 are indefinite because they include the term "substantial portion of a vertical market." Applicant has amended these claims to replace the term "substantial portion of" with the term – a plurality of entities in—. Applicant respectfully submits that these amendments do not narrow the scope of the claims.

The Examiner asserts that claim 14 is indefinite because the Examiner contends it is unclear which step is being performed when "advertising is available." Applicant has amended the claim to recite that "the step of printing advertising in the magazine includes printing advertising for products related to portions of selected threads . . . ." Applicant respectfully submits that this amendment does not narrow the scope of the claim.

The Examiner asserts that claims 23-25 are indefinite because there is no antecedent basis for “thread information.” Applicant has amended the typographical error in these claims to reflect that they depend from claim 22, rather than from claim 1.

The Examiner asserts that claim 32 is indefinite because he contends it is uncertain what structure is related to the “publishing means for providing a magazine . . . .” Applicant has amended the claim to delete the publishing means clause from the body of the claim. Applicant respectfully submits that this amendment does not narrow the scope of the claim.

The Examiner also asserts that claim 32 is indefinite because he concludes it is not clear whether the printed magazine includes the advertising or the claim omits structure responsible for printing the advertising. Applicant has amended the claim to make it more readable. Applicant respectfully submits that this amendment does not narrow the scope of the claim.

The Examiner asserts that claims 49 and 50 are indefinite because they use the term “recognizably similar.” Applicant has amended claims 49 and 50 to replace the term “recognizably similar” with language reciting that the format “assists readers in recognizing that the content is selected from the online subject matter.” Applicant respectfully submits that these amendments do not narrow the scope of the claims.

#### Response to Claim Rejection under 35 U.S.C. § 103(a)

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. By this reference, Applicant’s incorporate in their entirety their remarks set forth in their Amendment and Response to Office Action filed on July 10, 2008.

In rejecting the claims, the Examiner primarily relies on Tsuchida (JP 2001357142)(hereinafter “Tsuchida”). Tsuchida, however, does not teach or suggest using an online forum for interactive debate among the users to generate content for a publication. Although the system of Tsuchida provides for a posting of themes, it does not provide an online forum for interactive debate on the essays input by the users about those themes. On the contrary, Tsuchida specifically teaches that the system does “not publicly present the opinions, assertions and experiences of other people over the communication network, rather publishing them together in a publication” (0046). Thus, a user of the Tsuchida system cannot see other users’ essays. The goal of this is to “stimulate the sense of satisfaction of having one’s own opinions, assertions, experiences, etc. included in the publication, and the interest and curiosity of wanting to find out the opinions, assertions, experiences, etc. of other people on the theme in

question, thereby strongly exciting the desire to purchase the publication” (0046). In other words, the goal of Tsuchida is to stimulate the purchase of the published book at a later date by restricting prior online exchange and debate about the users’ essays. Tsuchida, therefore, does not utilize an “online forum in a common subject area,” nor does it generate forum “threads” (*i.e.*, a series of messages in an online discussion) as does Applicant’s invention.

Tsuchida also does not teach or suggest soliciting input from users on an area of interest to businesses in a vertical market. Although Tsuchida contemplates that user’s will provide input on different themes, those themes do not teach or suggest the vertical market aspect of Applicant’s invention. A vertical market is a group of similar businesses and customers that engage in trade in a specific industry having specialized needs. Tsuchida does not teach or suggest such a use. Instead, Tsuchida teaches a system and method that allows “consumers to enjoy reading books.” (*See* 0057, Abstract). Moreover, Tsuchida does not teach or suggest printing advertising in the published book related to a specific industry. Rather, it contemplates a business model whereby revenue is generated from stimulated sales of the book as discussed above, rather than advertising revenues.

Claims 1-13, 16-39 and 42-50

Claims 1-13, 16-39 and 42-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuchida. Applicants respectfully traverse this rejection.

*Claims 1-13 and 16-31*

Claim 1 is directed to a method of publishing a printed magazine. The method includes: providing the magazine to a plurality of entities in a vertical market comprising entities having interest in a common subject area; printing in the magazine portions of selected threads from an online forum in the subject area; and printing advertising in the magazine for at least one advertiser offering at least one product to at least some of the entities having interest in the common subject area.

Tsuchida does not teach or suggest all of the features recited in claim 1. For example, Tsuchida does not disclose “a plurality of entities in a vertical market.” Nor does Tsuchida disclose printing portions of “selected threads from an online forum in the subject area” or “printing advertising in a magazine for at least one advertiser offering at least one product to at least some of the entities having interest in the common subject area.”

In the Office Action, the Examiner argues that it would have been obvious to provide content for publications of any theme. Office Action at 6. The use of themes, however, does not teach or suggest the vertical market aspect of Applicant's invention.

The Examiner also suggests that Tsuchida discloses threads in an online forum because it allows consumers to post opinions, assertions and experiential accounts on a selected theme. Office Action at 6. Applicant respectfully disagrees. The term "online forum" contemplates interactive online discussion and debate among the online participants. Tsuchida does not teach or suggest such a forum. On the contrary, Tsuchida specifically teaches that the system does "not publicly present the opinions, assertions and experiences of other people over the communication network, rather publishing them together in a publication" (0046).

The Examiner also asserts that it is well known to subsidize a publication by advertising. Office Action at 6. Tsuchida, however, teaches away from such a business model. Instead, it contemplates a business model whereby revenue is generated from stimulated sales of the book, rather than advertising revenues.

Applicants submit, therefore, that Tsuchida does not teach or suggest all of the elements of claim 1.

Each of claims 2-13 and 16-31 depends from and includes all of the limitations of claim 1. For the reasons discussed above with respect to claim 1, Applicant submits that Tsuchida also does not teach or suggest all of the elements recited in Applicants' claims 2-13 and 16-31.

With respect to claim 9, Tsuchida also does not teach or suggest that "the entities must demonstrate qualification in the subject area to access the online forum," as recited in the claim. Similarly, with respect to claim 10, Tsuchida also does not teach or suggest that "the entities are required to correctly answer a qualifying question in the subject area before being allowed to participate in the online forum," as recited in the claim. The Examiner asserts that it would have been obvious to require users to demonstrate qualification in the subject matter to avoid unwanted postings. Office Action at 7. Applicant respectfully disagrees because there are other means for removing unwanted postings. For example, Tsuchida teaches that the user input can be edited after it is collected (*see* 0027).

With respect to claims 11-13, Tsuchida also does not teach or suggest that "a criterion for selecting the threads from an online forum is the popularity of the threads," that "the popularity of the threads is measured by the number of thread entries" or that "the popularity of the threads

is measured by the number of entities contributing to the threads,” as recited in one or more of the claims. Rather, Tsuchida teaches away from measuring thread popularity because it teaches away from allowing the users to engage in any online debate that could generate threads.

With respect to amended claim 16, Tsuchida also does not teach or suggest printing portions of selected threads “in the magazine in a format that assists readers in recognizing that the selected threads are from the online forum” as recited in the claim. The Examiner asserts that any readable format would have been recognizably similar to that in the online forum. Office Action at 6. Applicant respectfully disagrees. In any event, as discussed above, Applicant has amended claim 16 so that it no longer includes the term “recognizably similar.”

With respect to claims 17-29, Tsuchida also does not teach or suggest any of the recited features regarding the selected threads. As discussed above, however, Tsuchida teaches away from utilizing a forum for generating any threads.

Applicant respectfully submits, therefore, that Tsuchida does not render claims 1-13 and 16-31 unpatentable.

#### *Claim 32*

Amended claim 32 is directed to a publishing system for providing a magazine to a plurality of entities in a vertical market comprising entities having interest in a common subject area. The system includes in combination: means for obtaining from an online forum in the subject area portions of selected threads in the subject area; and content means for printing in the magazine portions of the selected threads from an online forum in the subject area and advertising of advertisers desiring to offer products to the entities in the subject area.

Tsuchida does not teach or suggest all of the limitations recited in claim 32. For example, as discussed above, Tsuchida does not teach or suggest “means for obtaining from an online forum in the subject area portions of selected threads in the subject area” or “means for printing in the magazine portions of the selected threads from an online forum in the subject area” as recited in the claim. The Examiner argues that, in light of Tsuchida, it would have been obvious to publish, in a magazine, portions of threads from an online forum on a subject area because a magazine “is a common publication format that is easy to read.” Office Action at 6. Applicant respectfully disagrees. Even if a magazine is a common publication format, as discussed above, Tsuchida does not utilize an “online forum in a common subject area,” nor does it generate forum “threads” (*i.e.*, a series of messages in an online discussion) as does

Applicant's invention. On the contrary, the goal of Tsuchida is to stimulate the purchase of the published book at a later date by restricting prior online exchange and debate about the users' essays.

Applicant respectfully submits, therefore, that Tsuchida does not render claim 32 unpatentable.

*Claim 33-39 and 42-48*

Claim 33 is directed to a method of publishing content. The method includes, in combination, the steps of: ranking online forum threads by popularity; selecting at least one subset of popular topics for publication; editing the content of the at least one subset; and printing the content in at least one printed publication in a format that assists readers in recognizing that the content is from the online forum.

Tsuchida does not teach or suggest all of the limitations recited in claim 33. For example, Tsuchida does not teach or suggest "an online forum," or "ranking online forum threads by popularity" as recited in the claim. The Examiner argues that it would have been obvious to select the most popular forum threads for inclusion in the publication to provide a popular publication. Office Action at 7. As discussed above, however, Tsuchida teaches away from utilizing a forum for generating any threads.

Each of claims 34-39 and 42-48 depends from and includes all of the limitations of claim 33. For the reasons discussed above with respect to claim 33, Applicant submits that Tsuchida also does not teach or suggest all of the elements recited in Applicants' claims 34-39 and 42-48 and does not render those claims obvious.

With respect to claims 43-46 and 48, Tsuchida also does not teach or suggest any of the recited features regarding the thread information. On the contrary, Tsuchida teaches away from utilizing a forum for generating any threads.

Applicant respectfully submits, therefore, that Tsuchida does not render claims 33-39 and 42-48 unpatentable.

*Claim 49*

Amended claim 49 is directed to a method of publishing content. The method includes: providing at least one online forum; selecting at least one subset of online subject matter from the at least one online forum for publication; editing the content of the at least one subset of

online subject matter; and printing the content in a format that assists readers in recognizing that the content is selected from the online subject matter.

Tsuchida does not teach or suggest all of the limitations recited in claim 49. For example, as discussed above, Tsuchida does not disclose “providing at least one online forum,” “selecting at least one subset of online subject matter from the at least one online forum for publication” or “printing the content in a format that assists readers in recognizing that the content is selected from the online subject matter.”

Applicant respectfully submits, therefore, that Tsuchida does not render claim 49 unpatentable.

#### *Claim 50*

Amended claim 50 is directed to a system for publishing content. The system includes, in combination: means for providing at least one online forum; means for selecting at least one subset of online subject matter from the at least one online forum for publication; means for editing the content of the at least one subset of online subject matter; and means for printing the content in a format that assists readers in recognizing that the content is selected from the online subject matter.

Tsuchida does not teach or suggest all of the limitations recited in claim 50. For example, as discussed above, Tsuchida does not disclose “means for providing at least one online forum,” “means for selecting at least one subset of online subject matter from the at least one online forum for publication” or “means for printing the content in a format that assists readers in recognizing that the content is selected from the online subject matter.”

Applicant respectfully submits, therefore, that Tsuchida does not render claim 50 unpatentable.

#### Claims 14 and 40

Claims 14 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuchida in view of Kasai (US 2002/0169688)(“Kasai”). Applicants respectfully traverse this rejection.

Claim 14 depends from and includes all of the limitations of claim 1. For the reasons discussed above with respect to claim 1, Applicant submits that Tsuchida also does not teach or suggest all of the features of claim 14. Kasai does not cure these deficiencies of Tsuchida.

Claim 40 depends from and includes all of the limitations of claim 33. For the reasons discussed above with respect to claim 33, Applicant submits that Tsuchida also does not teach or suggest all of the elements of claim 40. Kasai does not cure these deficiencies of Tsuchida.

#### Response to Rejections Based on the Dental Practice Report

Claims 1, 2, 5, 16, 19, 26 and 29-32 stand rejected under 35 U.S.C. § 102 as being anticipated by the Dental Practice Report.

Claims 3, 4, 6-13, 17, 18, 20-25, 27, 28, 33-39 and 42-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Dental Practice Report.

Claims 14 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Dental Practice Report in view of Kasai.

Applicant respectfully traverses these rejections. As discussed above, Applicant's Rule 131 declaration establishes the invention of the subject matter of the rejected claims before the effective date of the Dental Practice Report reference. Therefore, the Dental Practice Report is not prior art and cannot be used, either alone or in combination with Kasai, as a basis for rejecting Applicant's claims.

#### Conclusion

Applicants respectfully submit that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore request that the Examiner reconsider all presently outstanding rejections, that they be withdrawn and that the claims be allowed. It is believed that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner



believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted,

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